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10/084,982	03/01/2002	Kevin McCarthy	042933/302169	2223

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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3691

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DELIVERY MODE

09/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/084,982

Applicant(s)

MCCARTHY, KEVIN

Examiner

SIEGFRIED E. CHENCINSKI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/02)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 5, 2008 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1, 10 and 18 are rejected under 35 U.S.C. 101** because the claimed invention is not supported by either a clearly asserted utility or a well established utility. The phrase "in full quality and full length" is indefinite because it lacks concreteness.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 1, 10 & 18 are rejected under 35 U.S.C. 112, first paragraph.**
Specifically, since the claimed invention is not supported by a clearly asserted utility or a

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well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

4. Claims 1, 10 & 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "enabling a user of the terminal to pre-study said received downloadable content in full quality and full length" is not supported by the specification. The examiner has been unable to find support for this limitation with the "in full quality and full length" component included. In fact, the phrases "in full quality" and "in full length" cannot be found in the specification in any context.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 10 & 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "in full quality and full length" is indefinite because it lacks concreteness. It could not be duplicated in its meaning by two independent practitioners except by mere chance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-18 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (hereinafter **Wiser**, US 6,868,403 B1) in view of Sasaki et al. (US PreGrant Publication 2002/0077988 A1, hereafter **Sasaki**).

Re Claim 1, **Wiser** discloses a method comprising:

- Opening a software application in a terminal (FIG 1; Client System "Web Browser.")
- Requesting downloadable content from the open software application (Column 16, lines 30-39)
- Automatically starting up a network session (Column 16, lines 36-42)
- Transmitting in said network session a request for downloading said downloadable content for the software application (Column 16, lines 42-47),
- Receiving said downloadable content of "unencrypted, lower quality 'clips' .. for free previewing by the consumer in order to decide whether or not to purchase the high fidelity version" (Column 2, lines 13-21; Col. 3, ll. 60-65. The usability is implicit);
- enabling a user of the terminal to pre-study said received downloadable content (Column 2, lines 13-21; Col. 3, ll. 60-65. The enablement is implicit).
- handling of payment for the pre-studied downloadable content for the software application for enabling storing of the pre-studied downloadable content for the software application without further user interaction beyond selecting the pre-studied downloadable content for storage (Col. 4, l. 15 – Col. 5, l. 20. Wiser teaches no further interaction beyond selecting the pre-studied downloadable content for storage since the payment arrangements have already been prearranged through the passport process for a given customer so that payment handling is automatically triggered upon the customer's choice step to download the pre-studied content.), and
- Storing of the pre-studied downloadable content for the software application from which the downloadable content for the software application was requested in response to handling of the payment (Column 10, lines 2-17, partic. ll. 5 & 14).

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Wiser does not explicitly disclose

- Receiving downloadable content in a form in which the downloadable content is usable for the software application for pre-study;
- in full quality and full length;
- wherein the terminal is a wireless terminal.
- Opening a software application in a wireless terminal.

However, **Sasaki** discloses receiving said downloadable content in a form in which said downloadable content is usable for the software application for pre-study, and further, the use of a portable wireless device for receiving digital content (Abstract, ll. 2-4). this implies opening a software application in a wireless terminal. Further, Sasaki discloses permitting users who have not as yet purchased the digital content to play back the digital content a limited number of times (page 3, [0033], ll. 6-10, 14-17) as well as an unlimited number of times ([0033]-ll. 10-14. In either case, it is obvious in **Sasaki** that a pre-study enables a user to receive downloadable content in full quality and full length. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to combine the disclosure of Wiser with that of Sasaki in order to use a wireless application protocol to provide data from a remote server to a mobile station, motivated by a desire to provide a novel digital content distribution scheme that enables digital content owners to reach new potential customers by leveraging the desire of users to share and exchange digital content, while protecting the commercial interests of digital content owners. (Sasaki, p. 1, [0005]-ll. 1-5).

Re Claim 2: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the requested downloadable content includes at least a graphic icon (Column 2, line 15 "graphics.").

Re Claim 3: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the networks session is a WAP session (Fig. 1)

Re Claim 4: Wiser in view of Sasaki discloses the claimed method supra and Wiser discloses wherein the WAP session is established with a pre-identified content provider (Column 6, lines 17-38; FIG 1; Refs 128-122-112)

Re Claim 5: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the user of the wireless terminal has an account at the pre-identified content provider, and wherein the handling of payment for said downloadable content includes transfer of an amount from said account to the content provider upon approval by the user (Column 17 line 53-Column 18 line 6).

Re Claim 6: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the storing of said downloadable content is enabled once the user has approved said payment (Column 18, lines 7-20).

Re Claim 7: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the WAP session is established with a pre-identified Internet portal hosting at least one content provider (Column 6, lines 17-38; FIG 1; Refs 128-122-112)

Re Claim 8: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the user of the wireless terminal has an account at the pre-identified Internet portal, and wherein the handling of payment for said downloadable content includes transfer of an amount from said account to the content provider upon approval by the user (Column 17 line 53-Column 18 line 6).

Re Claim 9: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the storing of said downloadable content is enabled once the user has approved said payment (Column 6, lines 40-42).

Re Claim 15: Wiser in view of Sasaki disclose the claimed method supra. Wiser in view of Sasaki does not explicitly disclose discarding the pre-studied downloadable content if the user does not select to store the pre-studied downloadable content. However, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have known that users of computer storage media often delete or discard stored material in which they have determined that they no longer care to keep that stored information. Such deletions make room for the storage of other information on that storage medium.

Re Claim 17, Wiser discloses a method, wherein automatically starting up the network session further comprises providing a plurality of available downloadable items

for selection based on a status of an account of the user (Fig. 3 shows "available items", and the payment capability is checked and payment authorized – Col. 4, ll. 65-66)..

Re Claims 10-14: Further wireless terminal claims would have been obvious from the previously rejected method claims 1-4 and 15, respectively, and are therefore rejected using the same art and rationale.

Re Claim 16, Wiser discloses a computer program product wherein an executable portion includes instructions for providing a plurality of available downloadable items for selection based on a status of an account of the user (Fig. 8; Col. 4, ll. 15-37, 58-59-a plurality of media being purchased.).

Re Claim 18, Wiser discloses an apparatus comprising a processor (Fig. 2 - 18). Wiser in view of Sasaki disclose configuration to open a software application in a wireless terminal, request downloadable content from the open software application, automatically start up a network session, transmit in said network session a request for downloading said downloadable content for the software application, receive said downloadable content, enable a user of the wireless terminal to pre-study said received downloadable content in full quality and full length (see the rejection of claim1). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to combine the disclosure of Wiser with that of Sasaki in order to use a wireless application protocol to provide a processor for the purpose of downloading content from a remote server to a wireless terminal, motivated by a desire to provide a novel digital content distribution scheme that enables digital content owners to reach new potential customers by leveraging the desire of users to share and exchange digital content, while protecting the commercial interests of digital content owners. (Sasaki, p. 1, [0005]-ll. 1-5).

Re Claim 19: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the requested downloadable content includes at least a graphic icon (Column 2, line 15 "graphics.").

Re Claim 20: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the networks session is a WAP session (Fig. 1).

Re Claim 21: Wiser in view of Sasaki discloses the claimed method supra and Wiser discloses wherein the WAP session is established with a pre-identified content provider (Column 6, lines 17-38; FIG 1; Refs 128-122-112).

Re Claim 22: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the user of the wireless terminal has an account at the pre-identified content provider, and wherein the handling of payment for said downloadable content includes transfer of an amount from said account to the content provider upon approval by the user (Column 17 line 53-Column 18 line 6).

Re Claim 23: Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses wherein the storing of said downloadable content is enabled once the user has approved said payment (Column 18, lines 7-20).

Re Claim 24: neither Wiser nor Sasaki explicitly disclose the handling of the payment based on a pre-existing agreement associated with the wireless terminal directly with an account. However, Wiser in view of Sasaki discloses the claimed method supra and Wiser further discloses a pre-existing account arrangement which electronically recognizes the account (Col. 25, ll. 6-9, 31-32). Sasaki discloses transactions with wireless accounts (see claims 5 and 22) and also discloses pre-paid accounts. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures and suggestions of the art of Wiser and Sasaki with what would have been obvious to the ordinary practitioner in order to handle the payment based on a pre-existing agreement associated with the wireless terminal directly with an account, motivated by a desire to provide a novel digital content distribution scheme that enables digital content owners to reach new potential customers by leveraging the desire of users to share and exchange digital content, while protecting the commercial interests of digital content owners. (Sasaki, p. 1, [0005]-ll. 1-5).

Response to Arguments

7. Applicant's arguments filed August 5, 2008 have been considered but are not persuasive.

ARGUMENT: Wiser fails to teach or suggest that handling of payment for enabling storing of pre-studied downloadable content for a software application is accomplished without further user interaction beyond selecting the pre-studied downloadable content for storage as provided in independent claims 1, 10 and 18'. (p. 9, l. 1 - p. 10, l. 29).

RESPONSE:

Wiser clearly enumerates the steps of prequalifying the customer/user in Col. 4, l. 15 through col. 5, l. 20 with the collection of financial payment data and related account payment information which Wiser calls a passport after which step the user only has to indicate the choice of something for download and saving on the user customer's medium without further customer interaction. The payment prequalifying steps are completed at Col. 5, l. 3, and the user's simple download choice proceeds in Col. 5, ll. 4-20.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIEGFRIED E. CHENCINSKI whose telephone number is (571)272-6792. The examiner can normally be reached on 9AM - 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SEC

September 1, 2008

/Narayanswamy Subramanian/
Primary Examiner, Art Unit 3691